



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov
DIW 02-02

Paper No. 6

LEE & HAYES PLLC
421 W RIVERSIDE AVENUE SUITE 500
SPOKANE WA 99201

COPY MAILED

FEB 28 2002

OFFICE OF PETITIONS

In re Application of :
Dideriksen, Feller, Harris, Novak, :
and Olson : DECISION REFUSING STATUS
Application No. 09/817,901 : UNDER 37 CFR 1.47(a)
Filed: 26 March, 2001 :
Attorney Docket No. MS1-788US :

This is in response to the petition filed under 37 CFR 1.47(a) on 29 November, 2001.

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor.

FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.

Extensions of time may be obtained in accordance with 37 CFR 1.136(a).

The above-identified application was filed on 26 March, 2001, without an executed oath or declaration.

Accordingly, on 29 May, 2001, Initial Patent Examination Division mailed a Notice to File Missing Parts of Nonprovisional Application, requiring, *inter alia*, the statutory basic filing fee, additional claim fee(s), a signed oath or declaration, and a surcharge for their late filing. A two (2) month period for reply was set.

In response, on 29 November, 2001, petitioners filed the present petition, accompanied by the petition fee, basic filing fee,

additional claim fee(s), the late filing surcharge, and a declaration naming Tedd Dideriksen, Chris Feller, Geoffrey Harris, Michael J. Novak, and Kipley J. Olson as joint inventors and signed by joint inventors Dideriksen, Harris, Novak and Olson on behalf of themselves and joint inventor Feller. The petition was also accompanied by a request and fee for a four (4) month extension of the time to reply to the Notice mailed on 29 May, 2001.

Petitioners state that inventor Feller was requested via email to sign the declaration, but has failed to do so.

A grantable petition under 37 CFR 1.47(a) requires:

- (1) proof that the non-signing inventor cannot be reached or located, notwithstanding diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);

- (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;

- (3) the petition fee;

- (4) a surcharge of \$130 or \$65 (small entity) if the petition and/or declaration is not filed at the time of filing the application, and

- (5) a statement of the last known address of the non-signing inventor.

The petition lacks item (1) and (2). In regards to item (1), petitioners have not shown that Feller was ever sent or presented with a copy of the application as filed (specification, including claims, drawings, if any, and the declaration). Petitioners should provide a copy of the cover letter transmitting the application papers to the non-signing inventor or details in an affidavit or declaration of facts by a person having first-hand knowledge of the details.

Likewise, before a *bona fide* refusal to sign the declaration can be alleged, petitioners must show that a copy of the application was sent or given to the inventor. If the inventor refuses in writing, petitioners must submit a copy of that written refusal with any renewed petition. If the refusal was made orally to a person, then that person must provide details of the refusal in an affidavit or declaration of fact.

In regards to item (2), the declaration is deficient in that it does not include the residence and mailing address and citizenship for joint inventor Feller. The oath or declaration

must identify the mailing address, and the residence if an inventor lives at a location which is different from where the inventor customarily receives mail, of each inventor.¹ The declaration supplied with the application papers also lacks the citizenship of joint inventor Feller.² A statement of the inventor's citizenship is a statutory requirement and cannot be waived.³ Petitioners must submit a new oath or declaration in compliance with 37 CFR 1.63 and 1.67 with any renewed petition.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
 Box DAC
 Washington, D.C. 20231

By FAX: (703) 308-6916
 Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
 2201 S. Clark Place
 Arlington, VA

Telephone inquiries related to this decision should be directed to the undersigned at 703-308-6918.



Douglas I. Wood
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

¹37 CFR 1.63(c).

²MPEP 605.01.

³35 U.S.C. § 115, MPEP 605.01.